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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,975	10/10/2002	Melanie Ann Pykett	025069-00001	9572

6449 7590 10/20/2004

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EXAMINER	
YU, GINA C	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/069,975	PYKETT ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 17, 2004 & July 01, 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 5-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2, 5-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of amendment and supplement amendment filed on June 17, 2004 and July 1, 2004, respectively. Claims 1, 2, and 5-10 are pending. Claim rejections made under 35 U.S.C. §§ 102 and 103 as indicated in the previous Office action dated December 17, 2000 are withdrawn in view of the claim amendment submitted by applicants. New rejections are made. Double patenting rejection as indicated in the same Office action is maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 2, 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that three antioxidants "each of which is selected from a different member of the group consisting of (a) ascorbic acid, its salts, esters, glucosides and glucosamines ; (b) morus alba. . . and (f) grape see oil". The use of conjunction "and" after the term "glucosides" in (a) renders the claim vague and indefinite since it is not clear whether the limitation requires one compound from group selected from (a) or the entire group of (a).

The remaining claims are rejected as depending on indefinite base claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 6524626 B2).

Chen teaches topical compositions comprising ginseng (Panax Ginseng) berry juice and extracts combined with other skin nutrients to provide essential vitamins and nutrients in a natural way. See abstract. Example 22 discloses a composition comprising 4% of ginseng extract, 2 % of grape seed extract, and 1 % of ascorbic acid. See also Examples 4, 6, 9, 13, 14, 20, 26, and 27, which contains at least three antioxidants recited in claim 1 wherein the total amount of the antioxidants exceed 5 % by weight of the total composition.

While the total amount of the antioxidants in Example 22 exceeds the recited 5 % in the instant claims, examiner notes that differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05 (II). The court in In re Aller held, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (C.C.P.A. 1955). The court in In re Hoeschele also held, "the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages". See 406 F.2d 1403, 160 U.S.P.Q. 809 (C.C.P.A. 1969). In this case, examiner takes the position that

the claimed composition comprising up to 5 % of the amount of the antioxidants is viewed prima facie obvious over the prior art composition comprising 6 % of the recited components. Particularly in view of the teaching of Chen 1) that ginseng extract is obtained by extensive extraction process, which would be costly; and 2) that high concentration of essential vitamins are found in ginseng, examiner takes the position that the artisan would have optimized the workable weight range of the ginseng extract in order to achieve cost-efficiency.

Regarding the applicants' claim of synergistic effect of the presently claimed invention, examiner notes that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the prior art teaches the compositions that comprise same active antioxidants as presently claimed in greater weight amount. Examiner views that it would have been obvious to the skilled artisan that the synergistic antioxidant effect as claimed is obviously present in both the prior art compositions and the compositions comprising the same ingredients with lesser amount as presently claimed, absent evidence to the contrary.

2. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen as applied to claims 1, 5, and 6 above, and further in view of Gubernick (US 6066327).

Chen is discussed above. The reference teaches the motivation to make multi-vitamin skin care composition from natural sources. See col. 2, lines 4-42. While the

reference illustrates formulas comprising ascorbic acid and generally teaches to combine vitamin C with the prior art invention, the reference fails to teach the specific vitamin C salt as recited in the present claims. The reference teaches to use ascorbic acid with ginseng extract in the composition as shown in Examples 9, 13, and 22. Example 9 discloses a composition comprising 5 % of ginseng extract, 2 % of grape seed extract, and 1 % of ascorbic acid. See also Examples 13, 20, and 26.

Gubernick discloses an antioxidant mixture for cosmetic composition, which comprises magnesium ascorbyl phosphate, and rosemary extract. See Example; col. 3, lines 39 – 40. The reference teaches using ascorbic acid or the derivative thereof, which indicates the art-recognized equivalency of the components. See col. 3, lines 41 – 50; Example. Magnesium ascorbyl phosphate is taught as the particularly preferred form of vitamin C. See Id.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Chen by substituting magnesium ascorbyl phosphate for ascorbic acid as motivated by Gubernick because 1) both references are analogous as they teach multi-vitamin and antioxidant cosmetic compositions; 2) Gubernick teaches the equivalency of ascorbic acid and magnesium ascorbyl phosphate and the preference for the latter; 3) and thus the skilled artisan would have had a reasonable expectation of successfully producing a skin care composition with enhanced or similar antioxidant property and multi-vitamin effects.

3. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen and Gubernick as applied to claims 1, 2, and 5-7 above, and further in view of Maybeck (US 5164182).

Gubernick teaches that rosemary extract is a well-known antioxidant in cosmetic art, used in the amount of 0.0001-1 % by weight. See col. 4, lines 1-20. See instant claims 8-10 (d). The reference also teaches using 0.01-20 % by weight of magnesium ascorbyl phosphate. See col. 3, lines 41 – 50; Example. See instant claims 8(c) -10(c). In Chen, morus alba is used by 1 % by weight.

While it is viewed obvious to the skilled artisan to reduce the amount of the ingredient for cost-efficiency, the claimed invention requires 0.0005 –0.01 % of morus alba.

Maybeck teaches using mulberry extract as a skin-lightening and anti-inflammatory agent. See instant claim 7. The reference teaches using dry mulberry extract in the amount ranging from 0.005 -1 wt %, most preferably 0.005-0.1 wt %. See col. 4, line 16. See instant claims 8 (b) -10 (b).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Chen by adding mulberry extract in low amount as motivated by Maybeck because of the expectation of successfully producing an anti-aging cosmetic composition with skin lightening and anti-inflammatory effects in low amount.

Double Patenting

Claims 1, 2, and 3-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/030147. Although the conflicting claims are not identical, they are not patentably distinct from each other because each sets of claims are directed to compositions comprising three antioxidants selected from the species of overlapping limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER